

ESTTA Tracking number: **ESTTA468435**

Filing date: **04/23/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

|                        |  |
|------------------------|--|
| Proceeding             | 92051465   |
| Party                  | Defendant<br>Edge Games, Inc., and Future Publishing, Ltd.   |
| Correspondence Address | TIM LANGDELL<br>EDGE GAMES INC<br>530 SOUTH LAKE AVENUE, 171<br>PASADENA, CA 91101<br>UNITED STATES<br>uspto@edgegames.com |
| Submission             | Other Motions/Papers   |
| Filer's Name           | Tim Langdell   |
| Filer's e-mail         | uspto@edgegames.com  |
| Signature              | /Tim Langdell/   |
| Date                   | 04/23/2012   |
| Attachments            | SecondFurtherResponseToBoardsOrderOf30Mar2012.pdf ( 8 pages )(741363 bytes )   |



1. Further to Co-Owner Edge Games, Inc's ("EDGE") further response to the Board's March 30, 2012 order, EDGE says as follows. Edge again asks this be considered.

2. In further support for the fact that in accord with the Motion on Consent of November 14, 2012 representing an agreement to dismiss the above captioned proceedings leaving all three of the registrations co-owned by Future Publishing Ltd ("Future") and EDGE in place as registered. EDGE reminds the Board that in parallel proceedings before the USPTO, Future is on record as claiming ownership of both trademark registrations Nos. 2,219,837 and 3,559,342. Please see the attached proof (Exhibit A) which is page 3 (of 7) of Future's filed Response to Office Action of June 27, 2011 in respect to their applications for the mark EDGE Ser. Nos. 85/153,981 and 85/153,958.

3. First, clearly there is no doubt that on November 14, 2010 when EDGE sought to file a Section 7 Voluntary Surrender of Reg. No. 3,559,342 EDGE was not the sole owner of that registration. Future clearly confirms that it owns part of this registration, just as it owns part of Reg. No. 3,105,816 (the registration whose voluntary surrender the Board already reversed). There is no question of this registration being divided in November 2010, or at all, so it is indisputable that EDGE and Future were co-owners of this registration at the time EDGE tried to voluntarily surrender it. This voluntary surrender was thus also invalid and clearly has to be reversed, leaving this registration as still registered in the names of both EDGE and Future as at the date of dismissal of the instant proceedings.

4. As to Reg. No. 2,219,837, In Future's filing in the attached exhibit from June 27, 2011, Future claims it is the sole owner of this trademark registration. And we see that it claims to own both the daughter registration (3,713,604) and the parent registration 2,219,837. Thus on the one hand we have the fact that usual procedure in the USPTO is that no action is

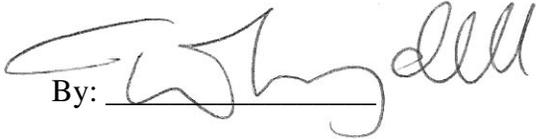
taken on a registration by the Post Registration department so long as there is a live action relating to that mark before the Board. Thus the registration 2,219,837 should not have been divided while the instant proceedings were ongoing and the division should be temporarily reversed until the instant proceedings are dismissed per the November 2010 Consent Motion (and then the division should be processed). But on the other hand, even leaving the question of reversing the division on one side for a moment, there is clear dispute between EDGE and Future as to the ownership of the remaining parent registration even post-division. Clearly in the attached Future claim they own that parent registration, too. For EDGE's part, we say that the remaining part of the original registration that is in EDGE's name should in fact still be partly in Future's name, and/or that part of the divided daughter registration (3,713,604) should be in EDGE's name. In short, there is clear dispute as to the registration 2,219,837 separate from the question of whether the division should be reversed. None of this dispute between Future and EDGE should be part of the instant proceedings that Petitioners and EDGE agreed to dismiss by Consent Motion in November 2010. Consequently, the instant proceedings should be dismissed with Reg. No. 2,219,837 still registered in either EDGE's name or jointly in EDGE's and Future's names so that the dispute over this registration (which is between EDGE and Future, and does not involve Petitioners) can be settled in a different and correct forum, involving, if necessary, different and separate proceedings before the Board.

5. In conclusion, the attached document filed by Co-Owner (Co-Defendant) Future in related proceedings before the USPTO proves that in addition to Reg. No. 3,105,816, at the very least Reg. No. 3,559,342 that is co-owned even at this time by Future should also remain registered to EDGE and Future at the dismissal of these proceedings before the Board. Further, Reg. No. 2,219,837 correctly, in accord with USPTO usual process and policy, should (a) have

its division reversed, (b) then the instant proceedings should be dismissed per the November 2010 Consent Motion leaving this registration still registered to both EDGE and Future as co-owners, (c) then after dismissal of these proceedings the Post Registration department should then process Future's application to divide the registration. As a separate issue not before the Board in the current proceedings, EDGE will then vigorously oppose any attempt by Future to divide this registration for many reasons well known to Future. Indeed, EDGE would have opposed and stopped the division of this registration in 2009 had EDGE been aware it was happening, since the division legally should not have taken place for reasons that are not of concern to the matters before the Board in these proceedings. In the alternate, at the time of dismissing these proceedings per the Consent Motion of November 14, 2010 this registration . 2,219,837 should in any event remain live and still registered (not canceled) in whatever owner's name the record currently stands since then, in separate proceedings not related to these, Future and EDGE will need to resolve who is the true owner of this registration and whether there should have been a division, and if so of which goods and services, since the current state of the Register is clearly disputed by Future (see attached) and disputed by EDGE.

Date: April 23, 2012

Respectfully submitted,

By: 

Dr. Tim Langdell, CEO  
EDGE Games, Inc.  
Registrant in *Pro Se*  
530 South Lake Avenue, 171  
Pasadena, CA 91101  
Telephone: 626 449 4334  
Facsimile: 626 844 4334  
Email: ttab@edgegames.com

# EXHIBIT A

Serial No. 85/153,981  
Examining Attorney: Julie A. Watson  
Law Office 109

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|  |                                       |
|--|---------------------------------------|
| In re Application of: Future Publishing Limited, LLC |                                       |
| Serial Number: 85/153,981                            | Julie A. Watson<br>Examining Attorney |
| Filed: October 15, 2010                              | Law Office 109                        |
| Mark: EDGE   |                                       |
| Commissioner For Trademarks                          |                                       |

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

### RESPONSE TO OFFICE ACTION

#### **I. Trademark Act Section 2(d), Likelihood of Confusion (Class 35)**

The Examining Attorney has refused registration of Applicant's EDGE trademark on the basis of alleged confusing similarity with prior registrations nos. 2,951,647, 3,097,321, 3,506,527 and 3,710,874. Applicant states that it has adequately distinguished itself from the prior registrations by removing the clause "Advertising, promotional and marketing services for others" and limiting the services in Class 35 as follows:

**Class 35:** computerised electronic on-line retail store services featuring computer games software and computer hardware.

Since the cited registrations are used in connection with very different subject matters, namely, (1) promoting Oklahoma's scientific and technological advantages for businesses, (2) market research services in the field of health care, (3) business and advertising services related to aviation, and (4) promoting the economic development of New York, Applicant respectfully requests that the refusal to register the mark EDGE on the Principal Register be withdrawn.

**II. Claim of Ownership Statement**

The Examining Attorney requested that Applicant submit a claim of ownership if it is the owner of U.S. Registration Nos. 2,219,837, 3,559,342, and 3,713,604. Applicant respectfully submits that it is the owner of U.S. Registration No. 3,713,604 pursuant to a partial assignment from Edge Interactive Media, Inc. and a subsequent renewal and division of the registration in Applicant's name alone. As for U.S. Registration Nos. 2,219,837 and 3,559,342, Applicant respectfully submits that it is the sole owner of such registrations as a result of (1) Edge Interactive Media, Inc.'s partial assignment of the registrations for certain of the goods to Applicant (see Assignments in Reel 2965, Frame 0742 recorded October 27, 2004 and Corrective Assignments in Reel 3159, Frame 0971 recorded September 15, 2005 and Reel 3186, Frame 0406 recorded November 2, 2005), and (2) Edge Games, Inc.'s (as the assignee of, and successor in interest to, Edge Interactive Media, Inc.) November 14, 2010 voluntary surrender with prejudice of its remaining partial interest in such registrations pursuant to a settlement reached with Electronic Arts, Inc. (See Exhibit A submitted herewith).

**III. Filing / Registration Basis**

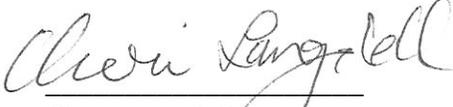
The Examining Attorney requests whether applicant intends to reply upon both Trademark Act Section 1(b) and Section 44(e) as filing bases. Applicant submits that it intends to rely on both Section 1(b) and Section 44(e) as filing bases. However, the international applications remain pending and have not yet registered. Applicant further states that it may drop the Section 1(b) basis later in the examination process.

Certificate of Service

In accordance with Rule 2.105(a) of the Trademark Rules of Practice, as amended, it is hereby certified that a true copy of the foregoing CO-REGISTRANT EDGE GAMES INC'S SECOND FURTHER RESPONSE TO BOARD'S ORDER DATED 30 MARCH 2012 AND REQUEST BOARD TO ACT ON CONSENT MOTION TO DISMISS INSTANT PROCEEDINGS DATED 11/14/10 in these proceedings was served on the following parties of record, by depositing same in the U.S. Mail, first class postage prepaid, this 23<sup>rd</sup> day of April, 2012:

Robert N. Phillips  
Reed Smith LLP  
101 Second Street, Suite 1800  
San Francisco, CA 94105-3659

Vineeta Gajwani  
Electronic Arts, Inc.  
209 Redwood Shores Parkway  
Redwood City, CA 94065

  
Cheri Langdell